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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/031,263	10/19/2001	Robert W. Monster	109888-130239	5037

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EXAMINER

JACKSON, JAKIEDA R

ART UNIT	PAPER NUMBER
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2626

DATE MAILED: 08/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/031,263	Applicant(s) MONSTER, ROBERT W.	
	Examiner Jakieda R. Jackson	Art Unit 2626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 June 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant argues that that the claimed invention generates an email message in a preferred language to avoid requiring a user to have software, which automatically translates the message upon receipt. Instead, the email is generated in the language determined to be the preferred language for the user. Clearly, translation occurs upon receipt of the email message in Berstis, rather prior to transmission as in the claimed invention. However, Berstis teaches the “set” which refers to a list of possible languages which the message may be composed in (column 8, lines 20-23). Besides, Applicant argues something that is not claimed. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., information is translated prior to transmission) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Nothing in the claims teach what language the information is composed in. Therefore, applicant's arguments are not persuasive.

Applicant further argues that Berstis provides no information about generation of surveys, let alone translation of emails related to such surveys prior to sending such emails. However, Applicant fails to provide any information on a survey system.

Applicant also argues regarding claims 10-11 and 21-22 that Crapo does not have a filing date prior to Applicant's priority date, and thus Applicant submits that a full

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examination requires a determination of whether the Crapo priority date supports what Crapo is cited for. Applicant requests copies of United States Provisional Patent Applications 60/150,461 and 60/150,237 from which Crapo claims priority. The Provisionals have been provided.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 6-7 and 17-18 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The term "survey system" is not mentioned in the specification. For examination purposes the term "survey system" has been interpreted as an inquiry system in which information such as source language, target language, fonts, etc. can be chosen.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. **Claims 1-9 and 12-20** are rejected under 35 U.S.C. 102(e) as being anticipated by Berstis et al. (USPN 6,901,367), hereinafter referenced as Berstis.

Regarding **claims 1 and 12**, Berstis discloses a method and apparatus comprising:

determining, as part of an electronic mail generation system, a preferred language (figures 3 and 4);

writing header information to an electronic mail message based on the preferred language (figure 3, elements 309, 311, 313 and 315 with figure 4, element 409 with desired language; column 4, lines 24-34 and column 7, lines 13- 18 and column 7, line 64 – column 8, line 3 with column 8, lines 17-23); and

writing a body to the electronic mail message (column 7, lines 19-21).

Regarding **claims 2 and 13**, Berstis discloses a method and apparatus comprising sending the electronic mail message to an electronic mail recipient (email transmitted; column 4, lines 24-34).

Regarding **claims 3 and 14**, Berstis discloses a method and apparatus wherein the preferred language is determined by querying a database of the system (user to request; column 4, lines 36-54 and column 6, lines 33-52).

Regarding **claims 4 and 15**, Berstis discloses a method and apparatus where the header information comprises character coding information based on the preferred language (column 5, lines 64 – column 6, line 4).

Regarding **claims 5 and 16**, Berstis discloses a method and apparatus wherein the character coding information comprises one or more of MIME-Version header field, a content type header field (figure 4, element 409 and column 7, lines 13- 18 with column 8, lines 17-23, a content transfer encoding field and a character set parameter of the content type header field (column 8, lines 57-65).

Regarding **claims 6 and 17**, Berstis discloses a method and apparatus wherein the electronic mail generation system is a part of a survey system (figure 2).

Regarding **claims 7 and 18**, Berstis discloses a method and apparatus wherein the electronic mail message is generated automatically in response to an event of the survey system (figure 2, element 220C and column 6, lines 5-31 with column 8, lines 20-22).

Regarding **claims 8 and 19**, Berstis discloses a method and apparatus wherein the recipient is expressed in a manner dependent on the preferred language (desired language; column 4, lines 24-34 with column 8, lines 20-22).

Regarding **claims 9 and 20**, Berstis discloses a method and apparatus further comprising sending the electronic mail message to the recipient expressed in the language manner (transmitting email; column 4, lines 24-54).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. **Claims 10-11 and 21-22** are rejected under 35 U.S.C. 103(a) as being unpatentable over Berstis in view of Crapo (US PG PUB 2004/0064371).

Regarding **claims 10 and 21**, Berstis discloses a language sensitive electronic mail generation, but lacks the method and apparatus further comprising determining a culturally appropriate salutation for the recipient based on the preferred language.

Crapo discloses an on-line registration system and method further comprising determining a culturally appropriate salutation for the recipient based on the preferred language (column 8, paragraph 0066), to verify identity.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Berstis's method and apparatus wherein it further comprises determining a culturally appropriate salutation for the recipient based

on the preferred language, as taught by Crapo, to provide sex/marital indicative titles, which helps to verify identity (column 8, paragraph 0068).

Regarding **claims 11 and 22**, Berstis discloses a language sensitive electronic mail generation, but lacks constructing the culturally appropriate salutation based on the recipient's name and the preferred language and writing to a body of the electronic mail message the culturally appropriate salutation.

Crapo discloses an on-line registration system and method further comprising:
constructing the culturally appropriate salutation based on the recipient's name (first, middle and last name) and the preferred language (preferred language; column 8, paragraph 0066); and

writing to a body of the electronic mail message the culturally appropriate salutation (e-mail message; column 8, paragraph 0070), to verify identity.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Berstis's method and apparatus comprising constructing the culturally appropriate salutation based on the recipient's name and the preferred language and writing to a body of the electronic mail message the culturally appropriate salutation, as taught by Crapo, to provide sex/marital indicative titles, in the preferred language, which helps to verify identity (column 8, paragraph 0068).


Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jakieda R. Jackson whose telephone number is 571.272.7619. The examiner can normally be reached on Monday through Friday from 7:30 a.m. to 5:00p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Hudspeth can be reached on 571.272.7843. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JRJ
August 13, 2006


**DAVID HUDSPETH
SUPERVISORY PATENT EXAMINER
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